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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10 021,746	12 11 2001	Matthias Eichm	4284	6354

21553 7590 03 17 2003

FASSE PATENT ATTORNEYS, P.A.
P.O. BOX 726
HAMPDEN, ME 04444-0726

EXAMINER

HOLLINGTON, JERMELE M

ART UNIT	PAPER NUMBER
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2829

DATE MAILED: 03 17 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,746

Applicant(s)

EICHIN ET AL.

Examiner

Jermele M. Hollington

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on Dec. 11, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-13, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on Dec. 22, 2000. It is noted, however, that applicant has not filed a certified copy of the Germany 100 64 478.3 application as required by 35 U.S.C. 119(b).

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, a first defined time window, a second time window [both of claim 5] and another signal output [claim 6] must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Information Disclosure Statement

3. The applicants have not provided a reference described in the specification on page 1 lines 22-23. The examiner is unable to have access to the reference. Therefore, the applicants should provide a legible copy of the reference as required under 37 CFR 1.98(a)(2) as well as list the reference on Information Disclosure Statement form PTO-1449 as required under 37 CFR 1.98(a)(1). Until this reference is provided as stated above, it has not been considered.

Claim Objections

4. Claims 1 and 16 are objected to because of the following informalities: instead of using "wherein" it should be replaced with --comprising--. Appropriate correction is required. [See section number 10 below for details.]
5. Claims 2-13 and 17 are objected to because of the following informalities: instead of using "wherein" it should be replaced with --further comprising--. Appropriate correction is required. [See section number 10 below for details.]

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-13 and 16-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 1, the claim recites, "...an IC which has at least one signal output and can be switched into a test mode..." It is not clear and concise from the specification what is switching the IC into a test mode. On page 5, lines 37-39, it states "*In the second operating mode, a define potential is set at the output OUT by means of the switch T1 connecting the resistor W1 to the load element RL, as a result of which the IC is switched into a test mode.*" On page 6, lines 16-18, it states, "...the switchover of the IC into the test mode is a function of the result of a logical operation of the set potential value and the control signal of an output stage of the IC." Also on page 7, lines 25-27, it states, "*In the second*

operation mode, there is no signal OS available at the node 10. The IC is thus switched into a test mode by an external wiring, provided that the potential value set at the node 50 lies within the interval of one the two window discriminators." Further, claim 1 recites, "a potential value is applied at the signal output..."

However, it is not clear, concise or described in the specification how the applicants determined the potential value and what is the potential value being used. Furthermore, it is not clear how the potential value when applied to the out helps switched the IC into a test mode.

Regarding claims 3-4, the claims recite, "specific potential values." However, it is not clear, concise or described in the specification how the applicants determined the specific potential value and what is the specific potential value. Furthermore, it is not clear how the potential value when applied to the out helps switched the IC into a test mode.

Regarding claim 5, the claim recites, "the potential at the signal output is compared with a define reference value within a first defined time window, and the IC is switched into the test mode in a second time window." On page 7, lines 26-29, it states, "...the potential value set at the node 50 lies within the interval of one of the two window discriminators...a potential, which lies within the voltage interval given by the first window discriminator, is set at the node 50 by means of the switch..." However, it is not clear from the specification what is the voltage interval of the window. It is not clear how these window discriminators help test the IC or even switch the IC to a test mode.

Regarding claims 10-11, the claims recite, "the potential value...lies within an interval of a window discriminator." On page 7, lines 26-29, it states, "...the potential value set at the node 50 lies within the interval of one of the two window discriminators...a potential, which lies within the voltage interval given by the first window discriminator, is set at the node 50 by means of the switch..." However, it is not clear from the specification what is the interval of the

window and how the applicants determine the interval of the window. It is not clear how these window discriminators help test the IC or even switch the IC to a test mode.

Regarding claims 12-13, the claims recite, "the potential value...lies within the voltage interval defined by the window discriminator." On page 7, lines 26-29, it states, "...the potential value set at the node 50 lies within the interval of one of the two window discriminators...a potential, which lies within the voltage interval given by the first window discriminator, is set at the node 50 by means of the switch..." However, it is not clear from the specification what is the interval of the window and how the applicants determine the interval of the window. It is not clear how these window discriminators help test the IC or even switch the IC to a test mode.

Since claims 2, 6-9 and 16-17 depend off of a rejected claim, they are also rejected for the above reason.

8. Claims 1-13 and 16-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 1, see above item number 8 for details

Regarding claims 3-4, see above item number 8 for details.

Regarding claims 5 and 10-13, see above item number 8 for details.

Since claims 2, 6-9 and 16-17 depend off of a rejected claim, they are also rejected for the above reason.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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10. Claims 1-13 and 16-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-13 and 16-17, the claims recite the term "wherein" in claims. This term is indefinite because "wherein" is a language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure or does not limit the scope of claims. [See MPEP 2106, part II, section C] The examiner will like to remind the applicants that any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." *Multi-form Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). If an applicant does not define a term in the specification, that term will be given its "common meaning." *Paulsen*, at 30 F. 3d 1480, 31 USPQ2d at 1674. However, if the applicants believe that the term has a meaning that relates with the term's art-accepted meaning, the examiner will to encourage the applicants to amend the claims [see above items # 4 and 5] to better reflect what applicants intends to claim as the invention.

Regarding claim 2, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "for example" and then narrow language. The Board stated that this can render a

claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 2 recites the broad recitation "means of a passive component," and the claim also recites "for example, a resistor." which is the narrower statement of the range/limitation.

Regarding claims 3-5 and 10-13, see above item number 8 for details.

Conclusion

Since there are numerous problem presented by the examiner above, a prior art rejection will not given at this time until clarification above questions has been resolved.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. O'Toole et al (5212442), Gans et al (5933378 and 6388926), Marr (6081464) and Tomita et al (6265889) disclose a method and apparatus for testing IC on a substrate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermele M. Hollington whose telephone number is (703) 305-1653. The examiner can normally be reached on M-F (9:00-4:30 EST) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on (703) 308-1233. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7382 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

Jermele M. Hollington
Examiner
Art Unit 2829

J. M. H.

JMH

March 6, 2003



KAMAND CUNEO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800